

Attorney Docket No.: **BERN-0082**
Inventors: **Eric F. Bernstein**
Serial No.: **10/533,353**
Filing Date: **June 16, 2005**
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REMARKS

Claims 1-7 are pending in the instant application. Claims 5-7 have been withdrawn from consideration by the Examiner and subsequently canceled without prejudice by Applicant herein. Claims 1-4 have been rejected. Claim 1 has been amended. Claim 2 has been canceled in light of amendments to claim 1. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Finality of Restriction Requirement

The Examiner has made final the Restriction Requirement mailed January 24, 2008. Accordingly, Applicant has canceled without prejudice nonelected claims 5-7. Applicant reserves the right to file a divisional application to the nonelected subject matter.

II. Rejection of Claims 1-4 under 35 U.S.C. 112, second paragraph

Claims 1-4 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner suggests that it is unclear what compounds are structurally similar to caffeine.

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Applicant respectfully disagrees as the specification makes clear at page 4, lines 4-20 that by "compound structurally similar to caffeine", it is meant it is meant a compound with a similar chemical formula and structure which exhibits similar photodamage protective properties to caffeine.

However, in an earnest effort to advance the prosecution of this case, Applicant has amended claim 1 to recite caffeine, theophylline or theobromine. Support for this amendment is found in original claim 2, now canceled.

Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 1-4 under 35 U.S.C. 102(b)

Claims 1-4 have been rejected under 35 U.S.C. 102(b) as being anticipated by Schroer (U.S. Patent 3,957,994) as evidenced by Perricone (U.S. Patent 5,409,693). The Examiner suggests that Schroer teaches a composition comprising theophylline useful in the treatment of inflammation of the skin such as sunburn. The Examiner has acknowledged that Schroer does not explicitly teach the protection against photoaging. However, the Examiner suggests that Perricone teaches that the very exposure to sunburn would have necessarily resulted in photoaging.

Applicant respectfully traverses this rejection.

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The instant invention relates to the discovery that caffeine and compounds structurally similar thereto such as theophylline and theobromine prevent photoaging through inhibition of the effects of solar radiation on human elastin promoter activity which lead to the deposition of massive amounts of abnormal elastic material, termed solar elastosis. See teachings in the specification at page 2, lines 20-25 and page 3, line 14 through page 4, line 3. In an earnest effort to advance the prosecution of this case and to clarify the instant invention, Applicant has amended claim 1 to recite a method of protecting humans exposed to sunlight against solar elastosis and photoaging.

There is no express teachings in either Schroer (U.S. Patent 3,957,994) or Perricone (U.S. Patent 5,409,693) relating to solar elastosis. Nor is it inherent from teachings of Schroer (U.S. Patent 3,957,994) or Perricone (U.S. Patent 5,409,693) that a compound taught by Schroer to be useful as an anti-inflammatory agent would be useful in protecting humans exposed to sunlight against solar elastosis and photoaging. Accordingly, these references cannot anticipate the instant claimed invention. See MPEP 2131.

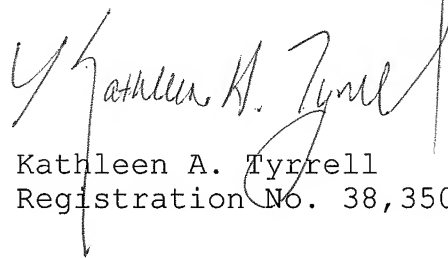
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IV. Conclusion

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



Kathleen A. Tyrrell
Registration No. 38,350

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515